

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

S116-USA

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on 07/28/08

Signature /Deanna L. Fintz/

Typed or printed name Deanna L. Fintz

Application Number

09/823,464

Filed

03/30/2001

First Named Inventor

Jerry OK

Art Unit

3714

Examiner

Nguyen, Binh An Duc

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. 37,124
Registration number

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

/Scott Dunbar /

Signature

Scott Dunbar

Typed or printed name

(818) 833-5055

Telephone number

July 28, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 3 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

REASONS ACCOMPANYING PRE-APPEAL BRIEF REQUEST FOR REVIEW

Rejections under 35 USC 103(a)

1. (non-final action) In the non-final action (NFA) dated August 8, 2007, the Examiner rejected pending claims 1-17 and 37-40 under six 35 USC 103 (a) grounds: 1) Claims 1, 2, 8, 9, 12 and 17 as being unpatentable over Szobonya; 2) Claims 1-17 as being unpatentable over Mizuhara in view of Chirino; 3) Claims 37 and 39 as being unpatentable over Szobonya in view of Poniatowski; 4) Claims 37, 39, and 40 as being unpatentable over Mizuhara in view of Chirino and further in view of Poniatowski; 5) Claim 38 as being unpatentable over Szobonya and Poniatowski as applied to claim 37 and further in view of Greuter; and 6) Claim 38 as being unpatentable over Mizuhara, Chirino, Poniatowski as applied to claim 37 and further in view of Greuter.

2. (response to non-final action) In Appellants' reply (AR1) of November 14, 2007, Appellants amended independent claims 1, 8 and 37, and dependent claim 39. Appellants provided arguments against grounds 1)-6) as shown in sections IIIA through IIIF of Appellants' reply, for a total of about 5 and half pages of arguments.

3. (final action) In response, the Examiner mailed a Final Action (FA) on February 5, 2008, where all of the Examiner's arguments of the NFA were copied at pages 2-11 of the FA. Moreover, in the section "Response to Arguments" of the FA, the Examiner addressed all four of the Appellants' arguments against grounds 1)-4) in the same manner: a) summarizing the Appellants' arguments; b) just stating that the arguments were "deemed not to be persuasive"; and c) just copying the same arguments (with the same words) provided in the NFA and in the corresponding portion of pages 2-11 of the NFA. Therefore, the sum total of the rejecting arguments provided by the Examiner in the NFA + FA consisted of: Grounds 1)-4) repeated three times (one time in the NFA and two times in the FA), and Grounds 5)-6) repeated two

times (one time in the NFA and one time in the FA). Astonishingly, no additional word was spent by the Examiner, in the FA, to address the Appellants' arguments. In doing so, the Examiner committed **clear error** because he did not answer to the substance of the Appellants' arguments of AR1. There was no rational underpinning of the Examiner linking a) (the summary of the Appellants' arguments) with b) (the Examiner's literal copy of his previous arguments) to establish c) (i.e. that the Appellants' arguments are not persuasive).

4. (response to final action) Appellants replied (AR2) to the FA on May 1, 2008, immediately noting (see first paragraph of Appellants' "Remarks" section) the incompleteness of the FA under MPEP 707.07(f). In addition to that, Appellants provided additional and new arguments to bolster and reinforce Appellants' previous, unanswered, remarks in AR1. Appellants concluded AR2 by requesting, at a minimum, a new and proper FA (see page 4 of Appellants' AR2).

5. (advisory action) The Examiner answered to AR2 by way of an Advisory Action (AA), on June 20, 2008. The AA was rather long, and Appellants' initial optical impression was positive in view of the apparently long dissertation of the Examiner, consisting of a preamble and four full, long, paragraphs. However, upon reading of the Examiner's arguments, Appellants were astonished in noting that those four paragraphs were again a copy of Grounds 1)-4)! Therefore, also in this case, the Examiner committed **clear error** because he did not answer to the substance of the Appellants' arguments of AR2. In this latter case, the Examiner did not even bother summarizing the Appellants' arguments in AR2, let alone providing a rational underpinning linking the literal copy of his previous arguments with Appellants' arguments in AR2.

6. (conclusion) Therefore, in view of all of the above, Appellants respectfully submit that both the FA and the AA contain clear errors of the Examiner. Appellants thus respectfully request that the application be allowed on the existing claims and prosecution remain closed.

I hereby certify that this correspondence
is being electronically transmitted on

July 28, 2008
(date of deposit)

/Deanna Fintz/
(signature of person transmitting)

Respectfully submitted,

/Scott Dunbar Reg. No. 37,124/

Scott Dunbar, Esq.
Reg. No. 37,124

Second Sight Medical Products, Inc.
12744 San Fernando Road
Building 3
Sylmar, CA 91342
(818) 833-5055 voice
(818) 833-5080 facsimile